

Appl. No. : 09/997,310  
Filed : November 28, 2001

### REMARKS

This communication is responsive to the June 20, 2003 Office Action. Claims 1-35 were previously pending in this application. Applicants gratefully acknowledge allowance of Claims 27-35. Claims 36-37 are newly added. Claims 1, 2, 7, 9, 11 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,934,182 to Harter et al. ("Harter"). Claims 3-5 and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of U.S. Patent 6,326,754 to Mullet et al. ("Mullet"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of U.S. Patent 6,400,112 to Fitzgibbon et al. ("Fitzgibbon"). Claims 10, 12, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of U.S. Patent 5,850,828 to Valentino ("Valentino"). Claims 13-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Valentino in view of Mullet. Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Valentino in view of Fitzgibbon. Claims 13-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Mullet in view of U.S. Patent 5,450,841 to Whitaker ("Whitaker"). Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter, Valentino and Mullet in view of Whitaker.

Applicants would like to thank Examiner McCloud for the courtesies extended to Applicants' counsel, Perry D. Oldham, and Applicant John Ziegenhorn in a September 22, 2003 interview. Pursuant to MPEP § 713.04, the Harter, Mullet, Fitzgibbon, Valentino and Whitaker references were discussed with respect to the claims and possible claim amendments. Inasmuch as Harter teaches the advantages of upper and lower grilling surfaces, Examiner McCloud indicated that claim language excluding one of the grilling surfaces could overcome Harter.

Applicants hereby amend Claims 1, 7 and 21, and add Claims 36-37. Claims 1-37 are pending and presented for further consideration. Reconsideration of the application, as amended, is therefore respectfully requested.

### Rejection under 35 U.S.C. § 102

Claims 1, 2, 7, 9, 11 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Harter. Harter relates to a two-surfaced cooking apparatus. See, e.g., Harter at col. 4, lines 12-15.

Appl. No. : 09/997,310  
Filed : November 28, 2001

#### Claim 1

Harter discloses in the Background of the Invention the disadvantages of single surface grills:

Single surface grills are widely used in most restaurants for cooking a wide variety of food products. Many fast food restaurant menu items require cooking on both sides, and such restaurants have found it *advantageous to cook both sides at the same time* to expedite the cooking time. With a single surface grill it is necessary for the operator to turn, for example, hamburger patties over after they have been cooked on one side for cooking on the second side. This *increases the amount of operator attention required* for cooking these food products and also *increases the cooking time*.

\* \* \*

The present invention seeks to overcome these limitations by providing precise, controlled, *two-sided cooking* by means of an apparatus having a floating upper platen construction which allows for *complete control* of the degree of *pressure the upper platen* places on the food. The present invention also seeks to overcome these limitations by providing microprocessor control of both the upper platen operation and the entire cooking cycle. The upper platen according to the present invention is positioned substantially parallel to the patties and the lower platen prior to coming into contact with the patties. This optimizes cooked product quality and uniformity and minimizes operator involvement.

Harter at 1:9-20; 2:50-62 (emphasis added). Thus, Harter teaches away from the apparatus for grilling as recited in amended independent Claim 1. See M.P.E.P. § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims). Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

#### Claim 2

Claim 2 further recites a counterweight attached to the rear of the cover. Harter recites disadvantages to using a counter-balance:

Various two-sided grills have been made in which the upper cooking platen is mounted on a support arm for swinging movement about a horizontal

Appl. No. : 09/997,310  
Filed : November 28, 2001

axis between the lower cooking position and a raised position. On various two-sided grills the upper platen is *counter-balanced with a gas spring to assist in the manual lifting* of the platen at the completion of a timed cooking cycle. This *greatly limits the amount of pressure* that can be applied by the upper platen to the frozen patties when initially placed in the cooking position. Heat will not be quickly transmitted to the patties, and consequently, the patties will not achieve the desired amount of caramelization.

Harter at 1:59-2:3 (emphasis added). Thus, Harter teaches away from using "a counterweight attached at the rear of the cover." Claim 2, which depends from Claim 1, is believed to be patentable for the same reasons articulated above for Claim 1, and because of the additional features recited in Claim 2. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

#### Claim 7

Claim 7 further recites that the apparatus of Claim 1 is removable from the cover. Harter does not disclose that the linear drive motor 35 is removable from the cover, nor does Harter provide any motivation to do so. Claim 7, which depends from Claim 1, is believed to be patentable for the same reasons articulated above for Claim 1, and because of the additional features recited in Claim 7. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

#### Claim 9

Claim 9, which depends from Claim 1, is believed to be patentable for the same reasons articulated above for Claim 1, and because of the additional features recited in Claim 9. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

#### Claim 11

Claim 11, which depends from Claim 1, is believed to be patentable for the same reasons articulated above for Claim 1, and because of the additional features recited in Claim 11. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

Appl. No. : 09/997,310  
Filed : November 28, 2001

### Claim 21

As articulated with respect to Claim 1, Harter teaches the advantages of two-sided cooking, and teaches away from the cooking apparatus as recited in amended independent Claim 21. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

### Rejection under 35 U.S.C. § 103

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *See, e.g., In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The teaching or suggestion must be found in the prior art, not in the applicant's disclosure. *See In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence" of motivation to combine. *Id.*

### Claims 3-5 and 22-26

Claims 3-5 and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of Mullet. There must be some suggestion or motivation to modify or combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See M.P.E.P. § 2143.01*. There is no suggestion or motivation in the references to modify the microprocessor controlled grill disclosed by Harter to include the garage door opening apparatus taught by Mullet.

Claim 3 depends from Claim 1, and further recites "a remote control for transmitting control signals to the motor." Claim 22 depends from Claim 21, and further recites "a remote control means for transmitting a control signal to the cover movement means." Claim 23 is an independent method claim that recites "causing a motor to operate upon receiving a first signal; the motor coupled to the cover such that operation of said motor causes an adjustment in the placement of the cover over the grilling surface; and causing the motor to stop operating upon receiving a second signal."

Appl. No. : 09/997,310  
Filed : November 28, 2001

Harter discloses the use of a microprocessor to control the gap setting between upper and lower platens to a very precise degree, down to (+/-) 0.0015 inch gradations. *See* Harter at 6:48-55. Fine control of the motor is needed to avoid crushing soft food, and controlling the motor remotely is not conducive to the fine control needed. *See, e.g.,* Harter at 7:51-55. Neither Harter nor Mullet provides motivation to replace the microprocessor controlled motor of Harter with the remote controlled motor of Mullet. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claim 8

Dependent Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of Fitzgibbon. As with Mullet, there is no suggestion or motivation in the references to modify the microprocessor controlled grill taught by Harter to include the garage door opening apparatus taught by Fitzgibbon. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claim 10

Dependent Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of Valentino. Harter teaches the use of temperature sensing thermocouple probes sending data to a microprocessor. The microprocessor activates heating elements when appropriate. *See, e.g.,* Harter at 5:55-60. Thus, the microprocessor controlled grill of Harter is not combinable with the charcoal briquette fueled grilling surface taught by Valentino, as charcoal briquettes are not conducive to activation or deactivation to maintain a constant temperature. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

#### Claims 12, 17 and 20

Independent Claim 12 and dependent Claims 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter in view of Valentino. Harter, however, teaches away from the cooking apparatus as recited in Claim 12. Claim 17, which depends from Claim 12, recites "a counterweight attached at the rear of the cover." As articulated above for Claim 2, Harter teaches away from using a counterweight attached at the rear of the cover. Claims 17 and

Appl. No. : 09/997,310  
Filed : November 28, 2001

20 are believed to be patentable for the same reasons articulated above for Claim 12, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claims 13-15 and 18

Dependent Claims 13-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Valentino in view of Mullet. Harter, Valentino and Mullet relate to a microprocessor controlled grill apparatus for simultaneous two-sided cooking of food items, a barbecue apparatus that includes a firebox, and a motorized door opener. The disclosures of Harter, Valentino and Mullet relate to different fields, and it would not have been obvious to combine these references. Further, as articulated above with respect to Claims 1, 2, 3-5 and 22-26, Harter teaches away from the combination of these references. Claims 13-15 and 18 are believed to be patentable for the same reasons articulated above for the respective independent claims, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claim 19

Dependent Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Valentino in view of Fitzgibbon. Harter, Valentino and Fitzgibbon relate to a microprocessor controlled grill apparatus for simultaneous two-sided cooking of food items, a barbecue apparatus that includes a firebox, and a motorized door opener, respectively. The disclosures of Harter, Valentino and Fitzgibbon relate to different fields, and it would not have been obvious to combine these references. Further, as articulated above with respect to Claims 1, 2, 8, 3-5 and 22-26, Harter teaches away from the combination of these references. Claim 19 is believed to be patentable for the same reasons articulated above for independent claim 12, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claim 6

Dependent Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter and Mullet in view of Whitaker. Harter, Mullet and Whitaker relate to a microprocessor

Appl. No. : 09/997,310  
Filed : November 28, 2001

controlled grill apparatus for simultaneous two-sided cooking of food items, a motorized door opener, and a control unit that remotely operates a gas fireplace, respectively. The disclosures of Harter, Mullet and Whitaker relate to different fields, and it would not have been obvious to combine these references. Further, as articulated above with respect to Claims 1, 3-5 and 22-26, Harter teaches away from the combination of these references. Claim 6 is believed to be patentable for the same reasons articulated above for independent claim 1, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### Claim 16

Dependent Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harter, Valentino and Mullet in view of Whitaker. Harter, Valentino, Mullet and Whitaker relate to a microprocessor controlled grill apparatus for simultaneous two-sided cooking of food items, a barbecue apparatus that includes a firebox, a motorized door opener, and a control unit that remotely operates a gas fireplace, respectively. The disclosures of Harter, Valentino, Mullet and Whitaker relate to different fields, and it would not have been obvious to combine these references. Further, as articulated above with respect to Claims 1, 2, 3-5 and 22-26, Harter teaches away from the combination of these references. Claim 16 is believed to be patentable for the same reasons articulated above for independent claim 12, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

#### CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

In view of the foregoing amendments and remarks, Applicants submit that the claims are patentably distinct from the cited art, and request that the application be allowed.

Arguments made with respect to specified claims apply only to those claims in this application and not other currently pending or later added claims in this or other applications. The amendment of a claim is not to be construed as acquiescence or admission that the cited art

Appl. No. : 09/997,310  
Filed : November 28, 2001

discloses the claim as previously read, and Applicants reserve the right to pursue such claims in a continuation or divisional application. Applicants traverse the original objections but have amended the claims in an effort to advance prosecution. Patentability is based on the claim as a whole, notwithstanding only a portion thereof is argued in support of novelty or non-obviousness. Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without entry of such amendments.

If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned attorney of record at his direct dial number of (949) 721-2961.

Respectfully submitted,

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Dated: 10/20/2003

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